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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/191,199	11/12/1998	PENG CHO TANG	238/130	8364

7590 06/25/2003

FOLEY & LARDNER
3000 K STREET, N.W., SUITE 5000
WASHINGTON, DC 20007-5109

EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 06/25/2003

36

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/191,199

Applicant(s)

TANG et al.

Examiner

Brenda Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 22, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-16, 18, 19, 41, 44, 45, and 47 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-16, 18, 19, 41, 44, 45, and 47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Claims 1-9, 11-16, 18, 19, 41, 44, 45 and 47 are pending in the application.

This action is in response to applicants' amendment dated April 22, 2003.

Response to Amendment

Applicant's arguments filed April 22, 2003 have been fully considered with the following effect:

1. With regards to the obviousness-type double patenting rejection as being unpatentable over U.S. Patent No. 6,486,185 in the last office action, the applicants stated that "nothing in the language of the claims motivates one to arrive at the present invention, rather than any of the various other numerous permutations of the claims of U.S. Patent No. 6,486,185". However, claims 1-6, 10-12, 21 and 41-52 of U.S. 6,486,185 embrace the compounds, compositions and method of use of the compounds as claimed herein where A, B, D and E are selected from the group consisting of carbon and nitrogen; R¹ is selected from the group consisting of hydrogen, alkyl, cycloalkyl, aryl, hydroxy, alkoxy, carboxy, C-amido and sulfonyl; R² is selected from the group consisting of hydrogen, alkyl, cycloalkyl and aryl; R³, R⁴, R⁵ and R⁶ are independently selected from the group consisting of hydrogen, alkyl, trihaloalkyl, cycloalkyl, alkenyl, alkynyl, aryl, heteroaryl, heteroalicyclic, hydroxy, alkoxy, aryloxy, -SH, -S-alkyl, -S-aryl, sulfinyl, sulfonyl, sulfonamido, carbonyl, carboxyl, cyano, nitro, halo, -OC(O)NR¹⁰R¹¹, N-carbamyl, -OC(S)NR¹⁰R¹¹, C-amido, N-amido, amino and -NR¹⁰R¹¹; Q is a heteroaryl group, where J is selected from the group consisting of oxygen, nitrogen and sulfur; K, L and M are independently

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selected from the group consisting of carbon and nitrogen; Z is a polar group selected from the group consisting of hydroxy, alkoxy, carboxy, nitro, cyano, carbamyl, amino, amido, ureido, sulfonamido, sulfinyl, sulfonyl, morpholino, piperazinyl and tetrazolo. Two patents cannot issue to the same invention.

Claims 1-9, 11-16, 18, 19, 41, 44, 45 and 47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 10-12, 21 and 41-52 of U.S. Patent No. 6,486,185. For reasons of record and stated above.

2. With regards to the obviousness-type double patenting rejection as being unpatentable over U.S. Patent No. 6,569,868 (U.S.S.N. 09/899,550) in the last office action, the applicants stated that "the compounds of this copending application require an imidazoline moiety to be attached to the oxindole, whereas in the pending claims of the present application, A can be N, O or S and B can be C or N". However, claims 1-6 of U.S. 6,569,868 embrace the compounds and compositions of the compounds as claimed herein where at least one of A, B, D and E is nitrogen; R¹ and R³ are independently selected from the group consisting of hydrogen, alkyl, cycloalkyl, aryl, hydroxy, alkoxy, C-carboxy, O-carboxy, C-amido, sulfonyl and trihalomethylsulfonyl; R² is selected from the group consisting of hydrogen, alkyl, cycloalkyl, aryl and halo; R⁴, R⁵ and R⁵ are independently selected from the group consisting of hydrogen, alkyl, alkenyl, alkynyl, cycloalkyl, aryl, heteroaryl, heteroalicyclic, halo, hydroxy, nitro, cyano, alkoxy, aryloxy, C-carboxy, O-

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carboxy, carbonyl, S-sulfonamido, amino and $-NR^{10}R^{11}$; J is nitrogen and G is carbon. Two patents cannot issue to the same invention.

Claims 1-9, 11-16, 18, 19, 41, 44, 45 and 47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,569,868. For reasons of record and stated above.

3. With regards to the obviousness-type double patenting rejection as being unpatentable over copending Application No. 09/190,931 in the last office action, the applicants stated that the compounds of this copending application teach structurally dissimilar compounds without suggesting the present. The obviousness-type double patenting rejection is herein maintained for the reasons stated above with regards to the applicants other copending application where is reiterated that two patents cannot issue to the same invention.

Claims 1-9, 11-16, 18, 19, 41, 44, 45 and 47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 09/190,931. For reasons of record and stated above.

4. The applicants arguments are sufficient to overcome the obviousness-type double patenting rejection as being unpatentable over copending Application No. 10/076,140 of the last office action, which is hereby **withdrawn**.

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5. With regards to the obviousness-type double patenting rejection as being unpatentable over copending Application No. 10/157,007 in the last office action, the applicants stated that the present invention does not require the phenylmethanesulfonyl moiety and therefore cannot be rendered obvious by the compounds of the claims of co-pending Application No. 10/157,007. The obviousness-type double patenting rejection is herein maintained for the reasons stated above with regards to the applicants other copending application where is reiterated that two patents cannot issue to the same invention.

Claims 1-9, 11-16, 18, 19, 41, 44, 45 and 47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 10/157,007. For reasons of record and stated above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Mondays and Tuesdays from 9:00 AM to 3:00 PM and from 5:30 PM to 7:30 PM and on Wednesday thru Friday from 9:00 AM to 6:00 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



Brenda Coleman
Primary Examiner AU 1624
June 24, 2003